

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

### Summary of the Rejections

The following identifies the authority and/or prior art applied to the identified claims for each rejection of the claims set forth in the Office Action dated June 6, 2001.

1. **Paragraphs 4 and 5:** Claims 53-55 are rejected under 35 U.S.C. Section 101 as directed to non-statutory subject matter.

2. **Paragraphs 6 and 7:** Claims 1-3, 5-7, 9-25, 27-29, 31-35, 37-40, 42-44, and 53-55 are rejected under 35 U.S.C. Section 102(a) as being anticipated by Archibald et al. U.S. Patent No. 5,825,883.

3. **Paragraphs 8 and 9:** Claims 4, 8, 26, 30, 36 and 41 are rejected under 35 U.S.C. Section 103(a) as obvious over the Archibald et al., U.S. Patent No. 5,825,883 in view of Official notice taken by the Examiner.

Applicant traverses the grounds for each and every rejection for at least the reasons set forth herein below.

### Applicant's Arguments

Applicant traverses the rejection, in **Paragraph 5**, of claims 53-55 as being directed to non-statutory subject matter. The claimed invention, as previously amended, is directed to a memory (an apparatus) having a software module containing a new arrangement of components that facilitate providing and billing software based upon use – and thus should not be classified as non-functional. In the event that this rejection is not withdrawn, Applicant requests an explanation of why the claimed elements are considered "non-functional" since each element performs a function in the context of facilitating automated distribution of software to customers (set forth in the preamble). The incorporation of the recited set of physical components within a software module provide advantages with regard to charging customers for use of such software modules. In reciting a set of elements stored within a single module, claims 53-55 define a physical entity and relationships rather than merely information, and thus define a patentable article of manufacture. See, *In re Lowry*, 32 F.3d 1579 (Fed.Cir. 1994). In the event that the rejection is not withdrawn, Applicant explicitly requests addressing the guidelines set forth in *In re Lowry*.

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

Applicant traverses the rejection, in **paragraph 7**, of claims 1-3, 5-7, 9-25, 27-29, 31-35, 37-40, 42-44, and 53-55 under 35 U.S.C. Section 102(a) as being anticipated by Archibald et al. U.S. Patent No. 5,825,883 in view of Applicant's amendments to independent claims 1, 31, 37, 42, and 53. In particular, nowhere does Archibald disclose or even remotely suggest measuring utilization of software based on registered uses of a software module, and wherein the registered uses of the software module are measured according to object instances created from an object class supplied by the software module. The elements added to claim 1 have been incorporated from previous claim 13 (now deleted). Nowhere does Archibald disclose a software use-based billing scheme linked to the instantiation of objects from object classes, and therefore cannot render the now amended claims unpatentable either alone or in combination with any other prior art presently known to Applicant.

The Office Action's rejection of claims depending from claims 1, 31, 37, 42, and 53 as anticipated by Archibald et al. are likewise traversed since such claims include the elements of these independent claims. Applicant addresses the Office Action's individual grounds for the rejection of the dependent claims herein below. Applicant reserves the right to further argue that there is no suggestion to combine particular references in the event that a further Office Action identifies additional references that contain elements that are not present in Archibald et al.

Applicant traverses the rejection of **claim 2** that recites "a customer creates a number of instances from a software module, and use is measured according to instances detected ...." Archibald et al. does not disclose monitoring the creation of instances (e.g., object instances created from an object class) of an item. Archibald et al. does not even disclose creation of such instances. Instead, the cited portion of Archibald et al., at col. 7, lines 40-67, discloses executing the downloaded electronic assets and charging a customer based upon use of the asset. The Archibald reference does not address making instances of that downloaded asset.

Applicant traverses the rejection of **claim 3**. Nowhere does Archibald et al. disclose instances created from a software module that are "periodically accessed to determine use." If the rejection is not withdrawn, Applicant respectfully requests identification of where Archibald, at col. 8, lines 1-37, teaches periodically accessing the instances to determine their use.

With regard to the rejection of **claim 5**, Applicant agrees that Archibald et al. contemplates a "trial use." However, Archibald does not disclose that the "trial use" option is associated with the recited "demonstration mode" of an instance.

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

Applicant traverses the rejection of **claim 6**. Claim 6 recites "a single agreement governing use of instances" created from software modules. However, Archibald et al. discloses a license that appears to apply to each downloaded copy of digital content rather than instances that are created from the downloaded digital content.

Applicant traverses the rejection of **claim 7** for at least the reason that Archibald et al. does not disclose "instances *derived from a software-module*." Furthermore, Archibald teaches termination when an amount (rent to own price) is reached rather than a termination date.

Applicant traverses the rejection of **claims 11 and 12** for at least the reason provided herein above with regard to claim 1. Claim 12 identifies a specific base for measuring use (i.e., execution of an object instance). Claim 13 was deleted because elements associated with the claim concerning monitoring instances created from software module object classes have been incorporated into each of the independent claims.

Applicant respectfully submits that, with regard to the rejection of **claims 14 and 15** Archibald et al. does not even disclose downloading an object class from which the specified objects are created/instantiated.

Applicant traverses the rejection of **claim 16** in view of the amendment to the claim indicating that the monitored duration is that of an object instantiated from the software module.

Applicant traverses the rejection of **claim 17**. Claim 17 is directed to a particular monitoring implementation that comprises "registering execution of an instance that tracks throughput of a process" and this indirectly measures value created by a process that uses the software modules. Applicant respectfully submits that nothing in column 5, line 65 to col. 6, line 12 even remotely discloses tracking process throughput or the particular method step recited in claim 17.

Applicant traverses the rejection of **claim 23**. The claim element recites "identifying the location of an instance created from a software module" obtained by a customer. Applicant respectfully submits that Archibald, col. 10, lines 1-13 does not disclose any location of software obtained by a customer.

Applicant traverses the rejection of **claim 24**. Claim 24 is directed to a failure by a license manager at a customer's site to communicate usage of software to a software brokerage. The failure is reported to a central licensing facility. In contrast, Archibald discloses a failure by an authority (e.g., a software brokerage) to properly communicate to a customer site.

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

Applicant traverses the rejection of **claims 27-28**. Archibald et al. col. 4, lines 30-34 does not disclose or even remotely imply that the downloaded software relates to industrial manufacturing software. If anything, Archibald et al. suggests that the downloaded digital content comprises consumer items such as articles, music, books, individual consumer software, etc.

Applicant traverses the rejection of **claim 29**. Archibald et al., as mentioned previously herein above, does not even disclose use of instances created from software modules.

Applicant traverses the rejection of **claims 32 and 33**. Archibald et al., as mentioned previously herein above, does not even disclose creating or executing object instances created from a software module, and therefore cannot disclose basing usage of the software modules on executing/creating such instances (e.g., instantiated objects) as recited in the claims.

Applicant traverses the rejection of **claim 34**. Claim 34 recites "registering use of the software module" to measure throughput of an industrial (e.g., manufacturing) process. Such element facilitates monitoring throughput of an industrial process (e.g., an assembly line, a batch process) to indirectly measure value created by the process using the software modules. Applicant respectfully submits that nothing in Archibald et al. column 5, line 65 to col. 6, line 67 even remotely discloses tracking process throughput or the particular method step recited in claim 17.

Applicant traverses the rejection of **claim 38**. Archibald et al., at col. 6, lines 33-47, merely discloses use identification information (in the meter data file), but does not suggest that this file is used to enable operation of executable software nor that it is transmitted during an authorization step.

Applicant traverses the rejection of **claim 40**. Archibald et al. col. 4, lines 30-34 does not disclose or even remotely imply that the downloaded software is industrial automation software. The cited section of Archibald refers to various manners in which the software is obtained by a consumer and does not relate in any way to the recited industrial automation software.

Turning to the rejection of **claims 53-55**, Applicant submits that the presently claimed invention comprises a defined article of manufacture wherein particular information is logically bundled within a single module that facilitates efficient and accurate marketing, distribution, and accounting of use by customers of software modules. Applicant traverses the rejection of claim

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

53 for at least the reason that Archibald et al. does not disclose a single module containing the recited object class. For at least this reason **claims 53-55** are not anticipated by Archibald et al.

Applicant now turns to the rejection of **claims 4, 8, 26, 30, 36 and 41** under 35 U.S.C. Section 103(a) as obvious over the Archibald et al., U.S. Patent No. 5,825,883 in view of Official notice taken by the Examiner. Applicant traverses the rejection of each of these claims since the Office has not provided a prima facie case of obviousness under 35 U.S.C. Section 103 with regard to any of these rejections. In the event this rejection is not withdrawn, Applicant requests provision of references disclosing: (1) the claim element, and (2) a disclosed suggestion for combining the element with the system disclosed in Archibald to render the claimed invention.

Applicant traverses the rejection of **claims 4 and 36**. Claims 4 and 36 recite registering use on a daily basis, and then charging a daily rate for use of an instance. The Office Action cites Archibald et al. at column 8, lines 38-56, that discloses generally measuring use in time increments. However, with regard to claims 4 and 36 Archibald does not disclose daily registering the use of the software. In the event that this rejection is not withdrawn Applicant requests provision of an actual reference in support of the Office Action's assertion that the modification of Archibald to include registering the use on a daily basis would have been obvious at the time of the invention.

Applicant traverses the rejection of **claims 8, 26 and 41** including the assertions that the recited elements are both well known in the art and that incorporation of such elements into Archibald et al. is suggested by the prior art. Applicant is unaware of the recited warning/reordering reminder in response to detecting a use credits expiration event. In the event that this rejection is not withdrawn, Applicant requests provision of a reference showing such a teaching in the prior art. At such time Applicant will assess whether such reference, taken in combination with the teachings of Archibald et al., renders claims 8, 26 and 41 obvious.

Applicant traverses the rejection of **claim 30**. In particular, though configuration tools were indeed well-known at the time of the invention, Applicant respectfully submits that the prior art does not suggest providing such tools to customize instances created from software modules in a method that includes charging a customer based upon monitored use of software modules. In the event that this rejection is not withdrawn, Applicant requests provision of a reference showing such a teaching in the prior art. At such time Applicant will assess

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

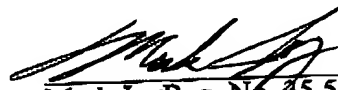
whether such reference, taken in combination with the teachings of Archibald et al., renders claim 30 obvious.

**CONCLUSION**

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application and all the pending claims to issue.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Mark Joy Reg. No. 35,562  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

Date: August 5, 2002

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as attached or enclosed) is being transmitted by facsimile to the United States Patent and Trademark Office, Attention: Examiner Nga B. Nguyen, Art Unit 3628, Facsimile Number (703) 305-7687, on the date indicated.

Date: August 5, 2002

Norma J. Arhas  
(Typed or printed name of person transmitting)

Norma J. Arhas  
(Signature of person transmitting)

**PATENT**  
Attorney Docket No. 202231

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Timothy C. Sowell

Art Unit: 3628

Application No. 09/418,943

Examiner: N.B. Nguyen

Filed: 10/15/99

For: DISTRIBUTING AND BILLING  
SOFTWARE ACCORDING TO  
CUSTOMER USE OF PROGRAM  
MODULES

**FAX RECEIVED**

AUG 05 2002

**OFFICIAL GROUP 3600**

**AMENDMENTS TO SPECIFICATION, CLAIMS, AND ABSTRACT  
MADE IN RESPONSE TO OFFICE ACTION DATED FEBRUARY 5, 2002**

*Amendments to existing claims:*

1. (Amended) A method for charging customers for use of software comprising the steps of:
  - establishing a use-based pricing scheme for a set of software modules;
  - distributing the set of software modules to a customer, wherein the set of software modules comprise at least one object class from which objects are instantiated on a customer system;
  - monitoring customer use of the software modules; and
  - charging the customer according to use of the distributed software modules as determined during the monitoring step, wherein software usage is measured according to object instances created from the at least one object class.

**Please delete claim 13.**

**Please amend claims 16, 31, 33, 34, 37, 42 and 53 as follows:**



In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

16. (Amended) The method of claim 1 wherein the monitoring step comprises determining a time duration that an object instantiated from a software module is active.

31. (Amended) A method for vending software in the form of software modules via electronic commerce channels comprising the steps of:  
maintaining an electronic commerce site including a software module selection interface, the software module selection interface enabling a customer to request a software module for use at a customer site, wherein the software module comprises at least one object class from which objects are instantiated on a customer system;

providing a software module management framework to the customer for installation at a customer site, wherein the management framework includes components for registering use of the software module at the customer site; and

charging the customer based upon registered use of the software module, wherein software module usage is measured according to object instances created from the at least one object class.

33. (Amended) The method of claim 31 wherein the use of the software module comprises creating an instance from the [downloadable] software module.

34. (Twice Amended) The method of claim 31 wherein registering use of the [downloadable] software module provides a measure of throughput of an industrial process.

37. (Amended) A method for charging customers for use of software comprising the steps of:

providing a set of individually identifiable units of [executable] software comprising at least one object class from which objects are instantiated on a customer system;

individually pricing ones of the set of individually identifiable units of [executable] software;

authorizing use of the executable software; and

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

charging a customer based upon use of selected ones of the set of individually identifiable units of [executable] software, and wherein software usage is measured according to object instances created from the at least one object class.

42. (Amended) A method for charging customers for use of software comprising the steps of:

first providing a set of software modules for software customers, wherein the set of software modules comprise at least one object class from which objects are instantiated on a customer system;

second providing a software licensing facility including a brokering facility through which software customers pay for software execution units, and wherein the brokering facility includes a set of software customer accounts; and

charging a software customer account a number of software execution value units based upon the value of software modules utilized by a customer, and wherein software module usage is measured according to object instances created from the at least one object class.

53. (Twice Amended) A memory containing a software module structure facilitating automated distribution of software to customers, the software module structure comprising:

a supplier identification;

a product description;

a billing definition; and

an executable program module including at least one object class from which instantiated objects are rendered.

Please insert new claims 74-77 as follows:

74. (New) The method of claim 11 wherein the registered uses of a software module are measured according to creating an object instance from the software module.

75. (New) The method of claim 42 wherein the use of the software module comprises executing an object instance created from the software module.

In re Appln. of Timothy C. Sowell  
Application No. 09/418,943

76. (New) The method of claim 42 wherein the use of the software module comprises creating an object instance from the software module.

77. (New) The method of claim 42 wherein registering use of the software module provides a measure of throughput of an industrial process.

m:\doelpat\mj\202231-and